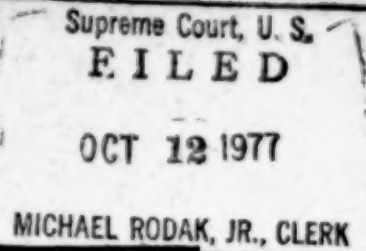


No. 77-74



**In the Supreme Court of the United States**

OCTOBER TERM, 1977

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**DANIEL B. COFER, ET AL., PETITIONERS**

**v.**

**LUTRELLE F. PARKER, ACTING COMMISSIONER  
OF PATENTS AND TRADEMARKS**

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**ON PETITION FOR A WRIT OF CERTIORARI TO  
THE UNITED STATES COURT OF CUSTOMS AND  
PATENT APPEALS**

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**BRIEF FOR THE RESPONDENT IN OPPOSITION**

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**WADE H. MCCREE, JR.,**  
*Solicitor General,*  
*Department of Justice,*  
*Washington, D.C. 20530.*

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**BRIEF FOR THE RESPONDENT IN OPPOSITION**

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**OPINION BELOW**

The decision of the United States Court of Customs and Patent Appeals (Pet. App. A) is unreported.

**JURISDICTION**

The decision of the Court of Customs and Patent Appeals is dated April 14, 1977, and was certified to the Commissioner of Patents and Trademarks on May 6, 1977. The petition for a writ of certiorari was filed July 13, 1977. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

**QUESTION PRESENTED**

Whether the Court of Customs and Patent Appeals correctly affirmed the determination of obviousness made by the Board of Appeals of the United States Patent and Trademark Office.

(1)

## STATEMENT

Petitioners seek review of a decision of the Court of Customs and Patent Appeals that affirmed the decision of the Board of Appeals of the Patent and Trademark Office holding that their apparatus for forming a cast copper bar into a copper wire was not patentable.

An obstacle to the production of copper wire from a cast copper bar is that impurities collect at the boundaries of the grains of the cast metal, creating so-called "columnar dendrites." The larger these grains are, the more likely the metal is to be brittle and to crack. Homogenizing the metal assures reduction of the grain structure but is time-consuming. A hot-rolling technique that successfully alters the grain structure is therefore desirable (Pet. 4-6).

Petitioners filed an application with the Patent Office on January 15, 1973 (Serial Number 323,471), to provide a hot-rolling technique for forming copper wire. The apparatus disclosed is of a general type previously used for aluminum and other metals. It takes a continuously-cast metal bar (Fig. 4, Tr. 20)<sup>1</sup> and works it through a set of rollers (Tr. 19, 20) at a temperature high enough to make it into a product of roughly elliptical shape (Fig. 6, Tr. 20), suitable for further hot-forming into wire.

The patent examiner rejected petitioners' claims for this apparatus, holding it to be obvious in view of prior art (see 35 U.S.C. 103),<sup>2</sup> i.e., "the Properzi patent in view of

<sup>1</sup>"Tr." designates the Transcript of Record filed in the Court of Customs and Patent Appeals. We are lodging a copy of this transcript with the Court.

<sup>2</sup>35 U.S.C. 103 provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of

the Baker, Very, and Edwards patents" (Tr. 66; Pet. App. 9a). The Properzi patent illustrates the forming of molten metal into a rod, which is then continuously rolled by hot-forming devices to produce rolled wire (Pet. App. 8a). The examiner concluded that the Very patent makes obvious the addition of a preliminary set of rolls to compact a newly cast strand of wire; the Baker patent illustrates that such rolls could be made adjustable; whereas the Edwards patent teaches that such rolls could be used to reshape metal to an elliptical shape (*id.* at 9a).

The Board of Appeals of the Patent and Trademark Office affirmed this decision (Pet. App. 6a-14a), noting that a person skilled in the art would know that hot-rolling breaks up the dendritic structure (Pet. App. 11a). Petitioners requested rehearing on the ground that the Board did not adequately recognize petitioners' claim that their device virtually destroyed the dendritic structure (Tr. 101-103). The Board denied the request for reconsideration, stating that as to this claim as well the invention was obvious (Pet. App. 15a-18a).

The Court of Customs and Patent Appeals affirmed the decision of the Board of Appeals (Pet. App. 1a-5a). It concluded, on the basis of the entirety of evidence before the Board, that petitioners' apparatus, as defined in their claims, would have been obvious to one of ordinary skill in the art. It noted that petitioners claimed that their apparatus would "substantially completely destroy the columnar dendritic structure in the cast bar" (Pet. App. 2a), but that petitioners had nonetheless admitted that

this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. \* \* \*



the Properzi apparatus will eliminate columnar dendrites after four or five roll passes (*ibid.*). Petitioners' claim that their apparatus was effective with "less than four roll stands" did not serve to distinguish their apparatus, since petitioners' own evidence showed that the unmodified Properzi apparatus could also, depending on variations in its operation, accomplish the desired result with less than four roll passes (Pet. App. 3a). The court concluded that the Properzi apparatus "varies from that instantly claimed only in the shape of one of the first four rolling channels," *i.e.*, the elliptical channel, and that the Edwards patent already teaches the use of elliptical rolling channels in rolling mills to impart an elliptical cross-section (*ibid.*).<sup>3</sup>

The court went on, however, to remark that it appeared that petitioners' solution of providing an initial hot-working of the metal in the form of a severe single compression might not be obvious to one of ordinary skill in the art. It found, however, that the appealed claims in their existing form did not relate to this single compression apparatus but rather constituted broadly drawn claims of an obvious nature (Pet. App. 4a).

#### ARGUMENT

Petitioners contend (Pet. 9-14) that the Court of Customs and Patent Appeals based its decision on new findings of fact and on a different theory than that advanced by the Board and therefore failed to "hear and determine [their] appeal on the evidence produced be-

<sup>3</sup>The court observed that it would be obvious to one of ordinary skill in the art that columnar dendrites would have a deleterious effect on the properties of copper and that dendrites could be eliminated by hot-rolling (Pet. App. 4a).

fore the Patent Office," as required by 35 U.S.C. 144.<sup>4</sup> In support of this contention, petitioners argue that while the Board had based its decision on the ground that the Properzi apparatus, as modified by the teachings of Baker, Very, and Edwards, rendered petitioners' apparatus obvious and unpatentable, the court held that the Properzi apparatus itself would achieve the result claimed by petitioners.

The court's review was entirely proper. The court based its decision solely on the evidence contained in the record (Pet. App. 1a-2a and n. 1). This complied with the statute. The court was not required to pass only on specific findings but was free to consider all the references relied on in the administrative proceedings. See, *e.g.*, *Application of Meinhardt*, 392 F. 2d 273, 280 (C.C.P.A.); *Application of Azorlosa*, 241 F. 2d 939 (C.C.P.A.).

While the court did place more emphasis on the similarities of petitioners' device to the Properzi apparatus than did the Board (Pet. App. 2a-3a), its decision did not rest upon a different theory or propound a new ground for rejecting petitioners' application. Petitioners exaggerate the difference between the court's and the Board's opinions. While the court emphasized the similarities of petitioners' and the Properzi apparatus, it nonetheless agreed with the Board that the use of the elliptical shaping device was obvious in light of the Edwards patent (Pet.

<sup>4</sup>35 U.S.C. 144 provides:

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

App. 3a), and that the "U.S. Steel reference" made obvious the utility of hot rolling to eliminate columnar dendrites (Pet. App. 2a, n. 1, 4a). Therefore the court, like the Board, based its decision on the conclusion that petitioners' apparatus was obvious both in light of Properzi and other references, including Edwards.<sup>5</sup>

Petitioners wrongly imply (Pet. 13-14) that the court's conclusion concerning the Properzi apparatus was made without adequate participation by them. Petitioners had ample opportunity to create a record distinguishing their apparatus from Properzi and others considered by the court; indeed, petitioners' description of the Properzi invention was relied upon by the court in its discussion concerning the similarities in performance. And petitioners did not avail themselves of the opportunity to request rehearing before the court (see C.C.P.A. Rule 6.1), as they could have done if they believed that the court's conclusions were based on a misapprehension concerning the record.

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<sup>5</sup>Petitioners contend (Pet. 14-16) that the court was incorrect in its discussion concerning the effect of the Properzi apparatus on dendritic structure, because it erroneously construed an exhibit showing a dendritic formation. The court's conclusion, in any event, has an alternate ground, based on petitioners' own evidence concerning variations in the performance of the Properzi apparatus in compressing a copper bar (see Pet. App. 3a), which petitioners appear not to challenge.

# CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

WADE H. MCCREE, JR.,  
*Solicitor General.*

OCTOBER 1977.